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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,187	09/21/2001	Karen E. Sandman	NEB -164-PUS	4950

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NEW ENGLAND BIOLABS, INC.
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EXAMINER

CELSA, BENNETT M

ART UNIT PAPER NUMBER

1639

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

file copy

Office Action Summary

Application No.
09/937,187

Applicant(s)
Sandman et al.

Examiner
Bennett Celsa

Art Unit
1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Status of the Claims

Claims 1-20 are currently pending.

NOTE: the location of the present application is ART UNIT 1639.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-3, drawn to a fusion protein comprising a SeCys peptide and surface protein.

Group 2, claim(s) 4-5, drawn to a SeCys containing surface protein.

Group 3, claim(s) 15, drawn to a library of SeCys terminal randomized peptides on the surface of an amplifiable genetic particle.

Group 4, claim(s) 19, drawn to a constrained randomized peptide library comprising one or more terminal SeCys.

Group 5, claim(s) 6-9, drawn to a recombinant method of incorporating SeCys on the surface of a genetic particle..

Group 6, claim(s) 10-14, drawn to a method of derivatizing SeCys in SeCys containing peptides attached to surface genetic particles..

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Group 7, claim(s) 16, drawn to a method for selecting novel ligands .

Group 8, claim(s) 17, drawn to a method for selecting predetermined enzyme activity.

Group 9, claim(s) 18, drawn to a method of identifying required DNA sequence elements for incorporating SeCys into peptides.

Group 10, claim(s) 20, drawn to a method for discovery of structurally constrained target ligands.

2. The inventions listed as Groups 1-10 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the compositions of groups 1-4 are directed to compounds (or libraries of compounds) which differ each from the other in chemical structure and/or physico/chemical/biological properties, which are capable of separate manufacture and/or use; and are directed to different and separately burdensome manual/computer searches and which entail different legal issues (e.g. under 35 USC 112/103/103 etc.) so as to not relate to a single general inventive concept. Additionally, the methods of groups 5-10 possess different method objectives and/or steps, utilize different reactants and/or reaction conditions and are capable of separate manufacture and/or use and are directed to different and separately burdensome manual/computer searches and which entail different legal issues (e.g. under 35 USC 112/103/103 etc.) so as to not relate to a single general inventive concept. There is no same or corresponding special technical feature which is recited to link any of the compound/composition inventions (e.g. groups 1-4) to any of the methods (e.g. groups 5-10). In

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any event it is noted that recombinant incorporation of SeCys into peptides/fusion proteins was known in the art. E.g. See US Pat. No. 5,272,078 and 5,700,600.

Election of Species (groups 1-10)

This application contains claims directed to the following patentably distinct species of the claimed invention:

- I. species of “amplifiable genetic particle” (Groups 1-6 and 8-10: e.g. see claims 2,5).**
- 2. species of “chemical derivitization of SeCys” (Groups 6 and 7: e.g. see claims 11-14).**

The search of different species of “amplifiable genetic particles” and/or “chemical derivatizations of SeCys” would result in different, divergent and separately burdensome manual/computer bibliographic searches in patent and literature databases.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

General information regarding further correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang (art unit 1639), can be reached at (703)306-3217.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1639)
June 20, 2003

BENNETT CELSA
PRIMARY EXAMINER

